

Application No. 09/696,754

Attorney Docket No.: 26119-136C US1

REMARKS/ARGUMENTS

In the Office Action, the Examiner noted that Claims 1-10, 12, 59-67 and 76-89 are pending in the above-identified patent application, that claims 76-87 and 89 have been withdrawn from consideration, and that claims 1-10, 12, 59-67, and 88 are rejected. Reconsideration is respectfully requested.

Election

Applicants acknowledge that claims 76-87 and claim 89 has been withdrawn from consideration as being directed to a separate or distinct invention.

Rejection of Claim 88 Under 35 U.S.C. § 112

The Examiner stated that claim 88 is indefinite because "there is recited only one first and one second networked user." Claim 88 has been amended to recite, "with at least one of first networked users and one of second networked users."

The Examiner also state that "[i]f both users are recited ... the users could be sending information to themselves." The claim states that the information bundles are "to be received from at least one of the first networked users and adapted to be sent to at least one of the second networked users."

Applicants respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn.

Rejection of the Claims 1, 2, 3, 5-10, 12, 59-63, 65-67 and 88 Under 35 U.S.C. § 103

Claims 1, 2, 3, 5-10, 12, 59-63 and 65-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowman U.S. Patent No. 6,601,234 ("Bowman-'234") in view of Milsted et al. U.S. Patent No. 6,345,256 ("Milsted") in further view of Lipkin U.S. Patent No. 6,721,747 ("Lipkin"). The Examiner also cites Official Notice (which Applicant hereby traverses as described below).

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Applicants respectfully traverse these rejections.

- a. **The Examiner Has Failed to Show Where Business Language Definition Descriptors that Specify the Descriptive Metadata of each of the Information Bundles are Shown in the Bowman Reference**

In rejecting independent claim 1, the Examiner cites portions of Bowman-'234 that merely disclose data of message sent from a sending system to a receiving system, where the data is translated based on metadata. In particular, the Bowman reference describes creating a stream that contains message data and metadata and using a message language to read the formatting information and metadata off of the stream. The Examiner has failed to show where business language definition descriptors that specify the descriptive metadata of each of the information bundles are shown in the Bowman reference. Applicant requests the Examiner to show what in Bowman the Examiner believes to teach or suggest "business language definition descriptors that specify the descriptive metadata of each of the information bundles" as required by claim 1.

- b. **Bowman does not Show or Suggest Deriving Traffic Statistics for the step of Distributing Based on Values for the Content Attribute Descriptors**

The Bowman reference does not show or suggest "deriving traffic statistics for the step of distributing based on values for the content attribute descriptors." The Examiner states that Bowman "discloses deriving attribute values for the purpose of auditioning" and that "[i]t is deemed an obvious variant of auditing to derive traffic statistics since that is what auditing is" (Office Action, page 3). Applicant respectfully submits that **this reasoning is circular**, and therefore, the Examiner has **not provided a prima facie case of obviousness**.

In addition, Applicant also disagrees that it is an obvious variant of auditing to derive traffic statistics with respect to the claimed combination. Applicant requests the Examiner to provide a prior art reference describing this allegedly well known feature in the context of the present invention or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicant requests withdrawal of this rejection.

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In support of his argument that Bowman does show or suggest limitations of claim 1, the Examiner cites a portion of Bowman that merely states that "attribute values may be obtained for auditing or rollback purposes" (Bowman-'234, column 200, lines 43-44). However, the Examiner has not pointed out that the Bowman reference shows that traffic statistics are derived **based on the values for the content attribute descriptors**.

Accordingly, without conceding that Bowman '234 shows or suggests any of the elements of the present invention, Bowman-'234 does not show or suggest "deriving traffic statistics for the step of distributing based on values for the content attribute descriptors," as required by claim 1.

c. The Combination Proposed by the Examiner of Milsted and Bowman does not Result in the Claimed Invention and Even if it did, the Combination is Improper

The Examiner also states that Milsted "derives by billing statistics based on the Product ID data in the metadata" and that Milsted uses "metadata to package content 113 for electronic distribution and then uses store 1-3 which uses the metadata for billing because it cannot access the content. (Office Action, pages 3-4). The Examiner further states that it would have been obvious to combine Milsted and Bowman. The Applicants respectfully disagree both because the proposed combination does not result in the claimed invention, and because even if it did, the proposed combination is improper.

Milsted is not related to the present invention, but relates to a method of automatically retrieving data associated with content. An identifier is read that is stored on electronic readable medium storing content.

In Milsted, Clearinghouse 105 keeps a record of all transactions and can report them to responsible parties, such as Electronic Digital Content Store 103 and Content Provider 101, on an immediate, periodic, or restricted basis. This reporting is a means by which Content Provider 101 can be informed of the sale of Content 113 and the Electronic Digital Content Store 103 can obtain an audit trail of electronic delivery to their customers. The Clearinghouse 105 can also notify the Content Provider 101 and/or Electronic Digital Content Store 103 if it detects that information in a SC has been compromised or does not comply with the Content's Usage

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Conditions. The transaction recording and repository capabilities of the Clearinghouse 105 database is structured for data mining and report generation. Accordingly, Applicant disagrees with the Examiner that combining Bowman '234 and Milstead et al. results in the presently claimed invention. Withdrawal of this rejection is respectfully requested.

Furthermore, the combination proposed by the Examiner is not suggested in either Milsted or Bowman and is therefore the result of impermissible hindsight reconstruction. Accordingly, Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103(a) is improper because it lacks the requisite motivation to make the combination suggested by the Examiner. Absent such a suggestion, it is improper to classify this type of modification as obvious.

**d. Bowman and Lipkin do not Show or Suggest
Managing Commercial Interactions Between Users Using Information Bundles**

The Examiner admits that Bowman-'234 does not disclose managing interactions between networked users using the information bundles. However, the Examiner states that "Lipkin discloses matching between metadata-based profiles and users (see cols. 113, 114, 115) to manage interactions e.g. matches between users." However, these columns of Lipkin, as the Examiner notes, refer to using profiles to "match information with users" (col. 113, lines 55-56). In contrast to the "managing commercial interactions ... using the information bundles," as required by claim 1, Lipkin is instead concerned with "employ[ing] meta-data based profiles to mach information with users" (col. 113, lines 55-56) and "matching of web resources" to "deliver a wide variety of resources, from webpages to Business Objects" (column 114, lines 34-36).

Even if the combination suggested by the Examiner did show or suggest limitations of the claimed invention, which it does not, the proposed combination is not suggested in either Bowman or Lipkin and is therefore the result of impermissible hindsight reconstruction. Accordingly, Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103(a) is improper because it lacks the requisite motivation to make the combination suggested by the Examiner.

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e. **The Examiner has not Indicated What He Believes to
Show or Suggest Each Claim Limitation of Claim 1**

The Examiner has given no indication of what the he believes to show or suggest that “each of the information bundles includes values for a plurality of information fields characterizing commercial interactions associated with at least one of the first and second plurality of different networked users” as claim 1 requires. The Applicant respectfully requests that the Examiner either withdraw this rejection or identify prior art that shows or suggests this limitation.

f. **Regarding the Official Notice,
Applicant Requests the Examiner to Provide an Affidavit or Prior Art Reference**

The Examiner states in connection with claim 65 that Official Notice is taken regarding the standard format of bundles. Applicant requests the Examiner to provide an affidavit or prior art reference, since Applicant does not believe that the present invention utilizes a standard format of bundles.

g. **What the Statistics are Used For is Not an Intended Use**

The Examiner states in connection with Claims 66 and 67, that what the statistics are used for is an intended use. Applicant respectfully disagrees. The Manual of Patent Examining Procedure (MPEP) specifically states at Section 2173.05(g), copy enclosed, the following:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. . . .

A functional limitation must be evaluated and considered, like any other limitation of the claim, for what it conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often in used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

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In addition, the Federal Circuit has confirmed that data is to be provided patentable weight over the prior art. For example, *In re Lowry*¹ held that the data structures are to be provided patentable weight. Therefore, with respect to all claims, as well as claims 66 and 67, Applicant requests the Examiner to withdraw the rejections.

Rejection of the Claims 1, 4 and 64 Under 35 U.S.C. § 103

Claims 1, 4, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowman-'234 in view of Milsted in further view of Lipkin and in further view of U.S. Patent 6,625,643 to Colby et al ("Colby").

Applicant traverses this rejection.

Colby et al., U.S. Patent 6,625,643, entitled "System and method for resource management on a data network" relates to a broadcast manager that automatically commits resources and sets up network interconnections to produce a broadcast session on a data network.

The Examiner has not provided clear guidance why one would have combined the Bowman, Milsted et al. and Colby et al. references, and even if combined, how the proposed combination results in the claimed invention. Colby et al. appears wholly irrelevant to the present invention.

The Examiner admits that "Bowman fails to disclose an event table to manage data based on user definable properties, e.g. events" but that "Colby et al. do disclose such a table" (Office Action, page 6). The Examiner, however, gives no indication of what in Colby he believes to be "such a table." Furthermore, the Examiner gives no indication of how the unidentified table in Colby, for example, "provides a sequence of activities with priorities, dependencies, execution methods, and requirements" as recited in claim 64.

The Examiner also states that "the event table in Colby et al. is read as the processing logic which is obviously capable of prioritizing billing" (Office Action, page 6). However, the

¹*In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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Examiner gives no indication of why the event table could be “processing logic” or, again, how Colby relates in any way to “convert[ing] traffic to billing amounts” as in claim 4.

The Examiner has, therefore, not made out a prima facie case of obviousness. The applicants have not been notified of “the reasons for such rejection, or objection, or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution” as is required by 35 U.S.C. §132.

Also, as described above, Bowman and Milsted et al. do not show or suggest the claimed features. In addition, as described above, Colby et al. does not provide any of the deficiencies of Bowman and Milsted et al. Accordingly, for these reasons as well, Applicant requests withdrawal of the above rejection, and such action is earnestly requested.

Thus, for at least the reasons set forth above, neither Bowman-’234, Milstead et al. nor Colby et al. show or suggest all the claimed feature of Applicants’ invention claimed in independent claim 1. Therefore, Applicants respectfully submit that independent claims 1 and 88 and dependent claims 2-10, 12, and 59-67, which depend from independent claim 1, are allowable over the prior art of record. Accordingly, Applicants request that the rejection of the claims should be withdrawn.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims.

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Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review

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of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

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